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EXAMINER

MADSEN, ROBERT A

ART UNIT PAPER NUMBER

1761

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,088

Applicant(s)

MARCHON ET AL.

Examiner

Robert Madsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 21-27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment Filed November 4, 2004 has been entered. Claims 10-20 have been cancelled and claims 21-27 have been added. Claims 1-9, 21-27 remain pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9,21-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Regarding claim 1, the limitation "substantially lacks rough edges and forming tool marks" is not described in the specification. The originally filed claims recited and the originally filed specification disclosed a confectionery that "essentially lacks an apex, rough edges, and forming tool marks". The specification does not define what is meant by "substantially lacks rough edges and forming tool marks" and how it differs, if at all, from a confectionery that "essentially lacks an apex, rough edges, and forming tool marks". Additionally, the entire originally filed disclosure is directed to a confectionery that essentially lacks an apex, but amended claim 1 is now outside the scope the invention (i.e. it does not "essentially lack an apex).

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5. Regarding claim 21, the limitation that the confection “substantially lacks an apex” is not supported in the originally filed disclosure. It is not clear how, if at all, this differs from the originally filed disclosure where the confectionery “essentially lacks an apex, rough edges, and forming tool marks”.

6. Regarding claim 23, the limitation of “substantially coated” is not supported by the original disclosure. The originally filed claims recited and the originally filed specification disclosed a confectionery that *is* uncoated.. The specification does not state how confectionery that is *substantially* uncoated differs from a confectionery that *is* uncoated, but the term *substantially* uncoated implies that some coating may be present. The admission of the prior art teaches flaws of confectionery such as a protuberance (i.e. an apex) may be masked by coating (Paragraph 1, page 2), and it appears that the presently recited claims (e.g. especially claims 1 in light of 23, and 26) are directed to a confectionery that has an apex that is coated at the region around the apex to create a more rounded appearance. There is no support for the claim language.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 4, 21, 22 are rejected under 35 U.S.C. 102(b) as anticipated by Miura (JP 01030541) as evidenced by the admission of the prior art.

9. Miura teaches ice cream balls, as recited in claims 4 and 22, which substantially lack an apex, as recited in claim 21, rough edges, and forming tool marks since Miura teaches coating the extruded ice cream to create a "nearly spherical" shape (See JPO and Derwent Abstracts), and as evidenced by the admission of the prior art (Paragraph 1, page 2), coating will mask the flaws of an ice cream ball to create a round appearance. Miura inherently teach the cohesion ratio is greater than 95% since the ice cream ball is directly extruded into a mold for hardening, and therefore, the height of the ice cream ball is not reduced prior to hardening relative to exiting the extrusion nozzle and no deformation would occur.

10. Claims 1, 3, 4, 21, 22, 23 are rejected under 35 U.S.C. 102(b) as anticipated by Raitt (US 3809774).

11. Regarding claims 1, 4, 21, 22, 23, Raitt teaches ice cream balls, as recited in claims 4 and 22, which substantially lack an apex, as recited in claim 21, and rough edges, Additionally, the balls would substantially lack forming tool marks since they are formed in mold halves with a plastic strip inserted between the molds and is secured around/inside the balls at the location that a typical forming mark is seen (Figures, Column 1, line 65 to Column 2, line 50). Raitt inherently teach the cohesion ratio is greater than 95% since the ice cream is directly extruded into the molds for hardening,

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and therefore, the height of the ice cream ball is not reduced prior to hardening relative to exiting the extrusion nozzle and no deformation would occur.

12. Regarding claim 3, Raitt teaches extrusion but does not explicitly teach any particular temperature. However, as this is a product claim and the product of Raitt appears to meet the product characteristics (e.g. roundness), Raitt anticipates claim 3. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura (JP 01030541) as evidenced by the admission of the prior art, as applied to claims 1, 4,21,22 above, further in view of Ballew (US 1993130).

15. Miura teaches extruding ice cream via a nozzle (see Abstracts), but is silent in teaching the overrun is 80-100%. Ballew teaches the average overrun used by ice

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cream manufactures is 100%, and the overrun makes the ice cream light and fluffy , improves the taste, and effects the packaging requirement (Column 1, lines 37-50). Therefore it would have been obvious to select an overrun such as 100% since the average overrun selected by ice cream manufactures is 100%, and to further select overrun of 80-100% would have depended on the desired texture, taste, and package size desired.

16. Claims 5- 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura (JP 01030541) as evidenced by the admission of the prior art, as applied to claims 1, 4,21,22 above, further in view of Jadraque et al. (US 6025003).

17. Miura teaches ice cream balls, but is silent in teaching a lemon, strawberry, or pear or any particular diameter of the balls such as 30-70 mm with a volume of 14-180 ml or 30-40 mm and volume 14-25ml. Jadraque et al. teach it is desirable to make ice cream molds into complex shapes such spheres as well as fruit shapes, including a lemon shape (Column 1, lines 15-20 Example 2). Therefore, it would have been obvious to modify Miura and include a lemon shape since Jadraque et al. teach it is desirable to form lemon shaped ice cream and one would have been substituting one conventional ice cream mold design for another. Furthermore to select any particular dimensions (i.e. 30-40 mm and volume of 14-25ml) would have been obvious depending on the particular fruit selected to simulate (e.g. a lemon or a berry) and if it were also desirable to simulate the size as well as the shape of the individual fruit.

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18. Claims 8,9,24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raitt (US 3809774), as applied to claims 1,3,4,21,22,23 above, further in view of Porter field (GB 2139337A).

Raitt teaches a plurality of ice cream balls positioned within cells of strips of thermoformed plastic material enclosed by an exterior package as recited in claims 8,24,26, such as a cardboard box, or carton (Column 2, lines 8-22, Column 3, lines 45-55), as recited in claims 9, 25, and 27, wherein ice cream balls are placed upon mold cells, but Raitt is silent in teaches the ice cream balls are placed *upon* cells of the strips.

19. Porterfield, however, teaches ice cream balls positioned upon the cells of plastic strips wherein each strip is filled separately, like Raitt, to form a completed strip (Abstract, Page 1, lines 5-55) for the purpose of providing a hermetically sealed strip package wherein one may remove individual balls from the strips while the other balls remained hermetically sealed (Page 1, lines 81-110, Page 2, lines 90-123).

20. Therefore, it would have been obvious to include ice cream balls positioned upon the cells of plastic strips since Porterfield teaches by doing so one can provide a hermetically sealed strip that allows one to remove individual balls without exposing the others, and one would be simplifying the strips of Raitt since an external mold would not be required to form the balls.

Response to Arguments

21. Applicant's arguments filed November 4, 2004, with respect to the translation error have been fully considered and are persuasive. The rejections of claims 1, 3,4,6

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under 35 U.S.C. 102(b) as being anticipated by Durst (US 4674968) , claims 1,3,4
under 35 U.S.C. 102(b) as being anticipated by Hector et al. (EP 0797392 B1), Claims 1
and 4 under 35 U.S.C. 102(b) as being anticipated by Tarr (US 2716385), claim 2 under
35 U.S.C. 103(a) as being unpatentable over Durst (US 4674968) , claims 5 and 7
under 35 U.S.C. 103(a) as being unpatentable over Durst (US 4674968), further in view
of Jadraque et al. (US 6025003), and claims 8 and 9 under 35 U.S.C. 103(a) as being
unpatentable over Durst (US 4674968) further in view of Raitt (US 3817422) have been
withdrawn since the rejections were based on the now deleted translation error
("wherein its roundness is generated by revolution). However, upon further
consideration, a new ground(s) of rejection have been made for the reasons set forth
above.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. Beer (EP 749896 A2) teaches strips to receive pre-formed ice
cream balls.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE
MONTHS** from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen 
Examiner
Art Unit 1761

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